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PATENT APPLICATION

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IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Michael David Dobbs

Confirmation No.: 1706

Application No.: 10/676,488

Examiner: Akwasi Sarpong

Filing Date: September 30, 2003

Group Art Unit: 2625

Title: Method and Apparatus for Adjusting a Scanning Target Area of an Image Reproduction Device

Mail Stop Appeal Brief - Patents
Commissioner For Patents
PO Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL OF REPLY BRIEF

Transmitted herewith is the Reply Brief with respect to the Examiner's Answer mailed on 01/20/2010 .

This Reply Brief is being filed pursuant to 37 CFR 1.193(b) within two months of the date of the Examiner's Answer.

(Note: Extensions of time are not allowed under 37 CFR 1.136(a))

(Note: Failure to file a Reply Brief will result in dismissal of the Appeal as to the claims made subject to an expressly stated new ground rejection.)

No fee is required for filing of this Reply Brief.

If any fees are required please charge Deposit Account 08-2025.

Respectfully submitted,

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REPLY BRIEF

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Sir:

This is a Reply Brief under Rule 41.41 (37 C.F.R) in response to the Examiner's Answer of January 20, 2010 (the "Examiner's Answer" or the "Answer"). In Section 10, the Answer contains a response to some of the arguments made in Appellant's brief. Appellant now responds to the Examiner's Answer as follows.

Status of Claims

Claims 1-25 are pending in the application and stand twice rejected. Accordingly, Appellant appeals from the current rejection of claims 1-25.

Grounds of Rejection to be Reviewed on Appeal

The grounds of rejection to be reviewed on appeal remain unchanged by the Examiner's Answer. At issue is only a single rejection.

(1) Claims 1-25 were rejected under 35 U.S.C. § 103(a) as obvious in light of the combined teachings of U.S. Patent No. 6,147,743 to Fredlund et al. ("Fredlund") and U.S. Patent No. 6,204,937 to Takeda ("Takeda").

According, Appellant hereby requests review of this rejection in the present appeal.

Argument

(1) Claims 1-25 are patentable over Fredlund and Takeda:

Claim 1:

For ease of reference, claim 1 recites:

An image reproduction apparatus comprising:
a transparent scanning bed;
a scanning device optically coupled to said scanning bed, said scanning device comprising a photoconductive platen configured to receive light reflected off of an object on said scanning bed; and
an adjustable shade associated with said scanning bed;
wherein said adjustable shade is configured to be selectively extended from a position adjacent said scanning bed to cover a portion of said scanning bed including from an edge of said scanning bed to a leading edge of said adjustable shade, an underside of said shade presented to said scanning device through said bed being colored such that said scanning device outputs no image when scanning said underside of said shade thereby effectively reducing a size of said scanning bed.

(Emphasis added.)

In contrast to claim 1, the cited prior art does not teach or suggest the claimed apparatus with an “adjustable shade” that can “be selectively extended” to cover an edge of a scanning bed and that is colored such that, when scanned, no image is produced. This subject matter is clearly beyond the scope and content of the cited prior art.

THE CITED PRIOR ART:

As noted above, all Appellant’s claims are rejected in view of the combined teachings of Fredlund and Takeda. For convenience, a summary of each follows.

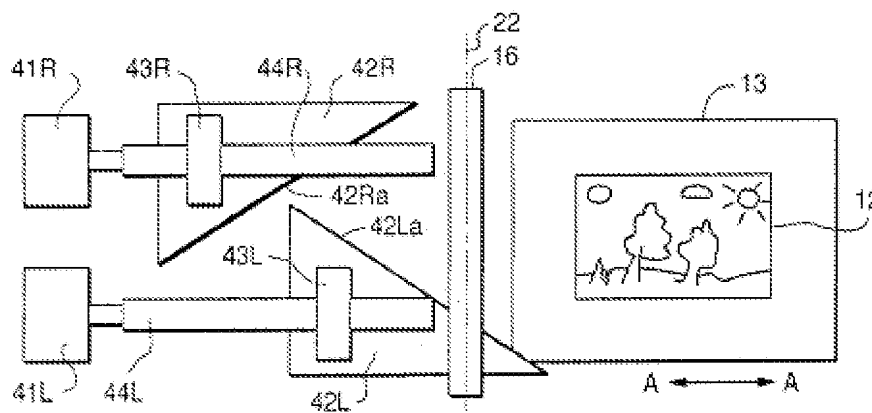
Fredlund teaches a mask or set of masks (Fredlund, Fig. 3) that can be used with a scanner. According to Fredlund, the

mask is placed over the photographic print to indicate an area of the print for copying and an operator control is provided on the copying station for selecting a desired copy size. The copying station includes a logic and control circuit that responds to the signal produced by the scanner to recognize the mask area, separates the image area

from the mask area, and resizes the image area to the selected copy size. The resized image is then printed by a printer in the copying station.”
(Fredlund, abstract).

Takeda teaches the following, exemplified by Fig. 8 of Takeda, which is reproduced below for ease of reference.

FIG. 8



As can be seen in the above reproduction of Fig. 8, Takeda teaches the use of light shielding plates 42R, 42L that are selectively advanced and retracted along axis A-A as a cassette 13 *transports* an original document or image 12 along axis A-A past a *stationary* scanning light source 16 that transmits light through the original 12 on the cassette 13 to detecting elements positioned beneath the cassette 13. (Takeda, Fig. 2, col. 6, lines 6-22).

(A) ADJUSTABLE SHADE

One embodiment of the subject matter of claim 1 is illustrated in Fig. 2 of Appellant's specification which is reproduced below. This figure shows the adjustable shades disclosed and recited in claim 1.

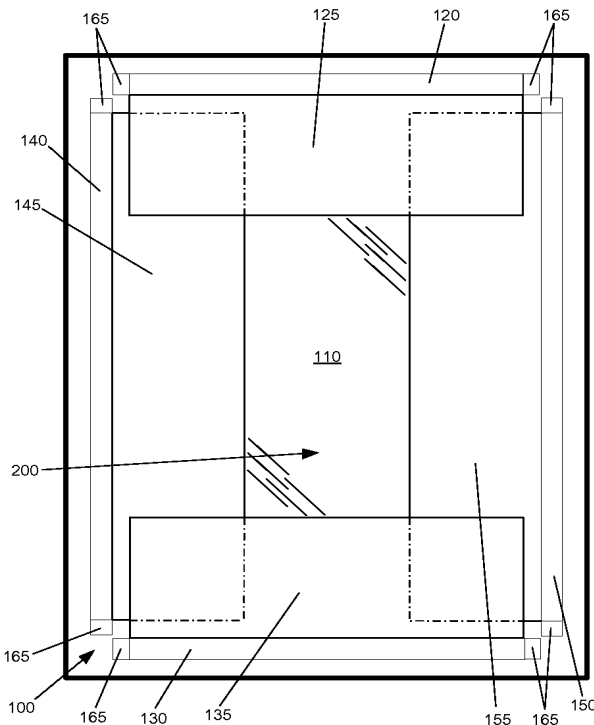


Fig. 2

Contrary to claim 1, Fredlund teaches a set of masks, one of which, is selected and placed between the document being scanned and a scanning bed. On the other hand, Takeda teaches angled plates that shield portions of an elongated light detector (CCD) from receiving light transmitted through a document being scanned. Takeda does not teach a scanning bed and does not teach any element that could be used to meet the language of claim 1 in conjunction with a scanning bed. Neither of the references, alone or in combination, suggests the claimed “adjustable shade [that] is configured to be selectively extended from a position

adjacent said scanning bed to cover a portion of said scanning bed including from an edge of said scanning bed to a leading edge of said adjustable shade.” (Claim 1).

One of skill in the art simply could not make the leap from the teachings of Fredlund and Takeda to what is recited in claim 1 without resorting to impermissible hindsight grounded in Appellant’s disclosure and claims. For at least this reason the rejection of claim 1 based on the combined teachings of Fredlund and Takeda should not be sustained.

(B) COLORED UNDERSIDE

The previous Office Action conceded that Fredlund does not teach or suggest “an underside of said shade presented to said scanning device through said bed being colored such that said scanning device outputs no image when scanning said underside of said shade thereby effectively reducing a size of said scanning bed.” (Action of 6/22/09, p. 3). The Answer now contradicts this earlier reading of Fredlund and refers to Fredlund at col. 3, lines 15-30 on this point. (Answer, p. 17).

As noted above, Fredlund teaches a system in which *everything*, including the mask, is imaged, with signal processing then separating the image of the mask from the remaining image to be printed. (Fredlund, abstract). Accordingly, the portion of Fredlund now cited by the Answer reads as follows. (Answer, p. 17). “The cropping mask may be made for example from cardboard, or sheet plastic and can be white, or some unnatural color to assist the signal processing electronics in separating the image of the mask from the selected image area of the picture.” (Fredlund, col. 3, lines 13-30).

Thus, Fredlund does not teach, as the Answer suggests, the claimed “underside of said shade presented to said scanning device through said bed being colored such that said scanning device outputs no image when scanning said underside of said shade.” (Claim 1).

To the contrary, the mask taught by Fredlund is imaged and then the signal processing electronics separate “the image of the mask from the selected image area of the picture.” (Fredlund, col. 3, lines 13-30).

Takeda likewise does not teach or suggest the claimed “underside of said shade presented to said scanning device through said bed being colored such that said scanning device outputs no image when scanning said underside of said shade.” (Claim 1). Rather, Takeda teaches “light shielding plates 42L and 42R which are positioned to one side of original cassette 13.” (Takeda, col. 5, lines 54-67). These plates simply block light from the light source (16) from reaching the imaging element (21). (Takeda, Fig. 2). There is no teaching or suggestion in Takeda that these plates have a colored underside that outputs no image when scanned.

Thus, neither Fredlund nor Takeda teach or suggest the claimed “underside of said shade presented to said scanning device through said bed *being colored such that* said scanning device outputs no image when scanning said underside of said shade thereby effectively reducing a size of said scanning bed.” (Claim 1) (emphasis added). For at least this additional reason, the rejection of claim 1 should not be sustained.

Under the analysis required by *Graham v. John Deere*, 383 U.S. 1 (1966) to support a rejection under § 103, the scope and content of the prior art must first be determined, followed by an assessment of the differences between the prior art and the claim at issue in view of the ordinary skill in the art. In the present case, the scope and content of the prior art, as evidenced by Fredlund and Takeda, did not include the claimed subject matter, particularly an adjustable shade that is “configured to be selectively extended from a position adjacent said scanning bed to cover a portion of said scanning bed including from an edge of said scanning bed to a leading edge of said adjustable shade” or “an underside of said shade

presented to said scanning device through said bed being colored such that said scanning device outputs no image when scanning said underside of said shade thereby effectively reducing a size of said scanning bed.” (Claim 1).

The differences between the cited prior art and the claimed subject matter are significant because the system recited by claim 1 provides a way to shield desired areas of a document from being scanned by a scanning device without requiring the motorized light blocking shields taught by Takeda or the set of masks separate from the scanning device taught by Fredlund. Thus, the claimed subject matter provides feature and advantages not known or available in the cited prior art. Consequently, the cited prior art will not support a rejection of claim 1 under 35 U.S.C. § 103 and *Graham*. For at least these reasons, the rejection based on Fredlund and Takeda of claim 1 and its dependent claims should not be sustained.

Claim 11:

Claim 11 recites:

A method of adjusting the target area of an image reproduction apparatus comprising:

selectively covering an edge of a scanning bed by drawing a shade over said edge of said scanning bed;

placing said object on said drawn shade; and

scanning said object;

wherein an underside of said shade that is presented to said scanning bed is colored such that said scanning outputs no image of said underside of said shade thereby effectively reducing a size of said scanning bed.

(Emphasis added).

Appellant wishes to here call attention to the recitation in claim 11 of “drawing a shade over said edge of said scanning bed.” (Claim 11). The verb “drawing” is defined as follows “to cause to move continuously toward or after a force applied in advance : pull ... :

to move (as a covering) over or to one side ... : to pull up or out of a receptacle or place where seated or carried.” (<http://www.merriam-webster.com/dictionary/drawing>). This definition is entirely consistent with what is disclosed and claimed by the Appellant.

In contrast, the combination of Fredlund and Takeda clearly does not teach or suggest “drawing a shade over said edge of said scanning bed.” (Claim 11). Rather, Fedlund teaches a set of masks, one of which, is selected and placed between the document being scanned and a scanning bed. On the other hand, Takeda teaches angled plates that shield portions of an elongated light detector from receiving light transmitted through a document being scanned. Takeda does not teach a scanning bed and does teach or suggest “drawing” a shade over an edge of a scanning bed.

Moreover, as demonstrated above the cited prior art does not teach or suggest “wherein an underside of said shade that is presented to said scanning bed is colored such that said scanning outputs no image of said underside of said shade thereby effectively reducing a size of said scanning bed.” (Claim 11).

Under the analysis required by *Graham v. John Deere*, 383 U.S. 1 (1966) to support a rejection under § 103, the scope and content of the prior art must first be determined, followed by an assessment of the differences between the prior art and the claim at issue in view of the ordinary skill in the art. In the present case, the scope and content of the prior art, as evidenced by Fredlund and Takeda, did not include the claimed subject matter, particularly a method of adjusting the target area of an image reproduction apparatus that comprises the steps of “selectively covering an edge of scanning bed by *drawing a shade over said edge of said scanning bed*” and “wherein an underside of said shade that is presented to said scanning bed is colored such that said scanning outputs no image of said underside of said shade thereby effectively reducing a size of said scanning bed.” (Claim 11) (emphasis added).

The differences between the cited prior art and the claimed subject matter are significant because the claimed subject matter provides feature and advantages not known or available in the cited prior art. Consequently, the cited prior art will not support a rejection of claim 11 under 35 U.S.C. § 103 and *Graham*. For at least these reasons, the rejection based on Fredlund and Takeda of claim 11 and its dependent claims should not be sustained.

Claim 14:

Claim 14 recites:

An optical scanner with an adjustable shade comprising:
a shade reel disposed at an edge of a scanning bed of said optical scanner; and
a shade coupled to said shade reel;
wherein an underside of said shade that is presented to said scanning bed is colored such that said optical scanner does not output any image markings when scanning said underside of said shade thereby effectively reducing a scan target area of said optical scanner.

(Emphasis added).

Fredlund and Takeda clearly do not teach or suggest “a shade reel disposed at an edge of a scanning bed of said optical scanner; and a shade coupled to said shade reel.” Neither reference teaches or suggests anything remotely like a shade reel disposed at the edge of a scanning bed. (*See* Appellant’s specification, paragraph 0028).

Nevertheless, the Answer argues as follows.

[T]he function of the shade reels [taught by Takeda] is to move the shade to the preferred position for scanning. Takeda teaches the same technology but uses different components such as nuts 43R and 43L and screws 44R and 44L. since the claimed invention is not claiming that the use of the shade reels which is disposed at an edge of a scanning bed of the said optical scanner makes the invention better than the conventional disclosure, Takeda's use of nuts and screws to perform the same function is the same and therefore teaches that claimed invention.

(Answer, p. 18).

Appellant notes that this argument is tantamount to admitting that the cited prior art does not, in fact, teach the claimed shade reel. Rather, the Answer is hoping that the nuts and screws

moving the light shielding plates of Takeda might be construed as the claimed “shade reel.” This is clearly unreasonable.

Takeda’s motorized screws that drive solid light shielding plates with respect to an elongated light detector (CCD) clearly are not the same thing as the claimed “shade reel.” Despite the abstract similarities noted in the Answer (Answer, p. 18), the motorized screws taught by Takeda do not include a “reel” and do not perform the same function of reeling out a shade as would the “shade reel” as recited in claim 14.

As explained in Appellant’s specification “the shades (125, 135, 145, 155) are concentrically wrapped around the shade reels in a coil configuration. This coiling will allow the shades (125, 135, 145, 155) to be drawn from the shade reels (120, 130, 140, 150) in such a way as to allow the shades (125, 135, 145, 155) to be retracted back into the shade reels (120, 130, 140, 150) upon completion of their use.” (Appellant’s specification, paragraph 0028). There is nothing like the claimed shade reel or its disposition at the edge of a scanning bed in the prior art of record. For at least this reason, the rejection of claim 14 should not be sustained.

Additionally, as demonstrated above, Fredlund and Takeda fail to teach or suggest the claimed “*underside of said shade that is presented to said scanning bed is colored such that said optical scanner does not output any image markings when scanning said underside of said shade* thereby effectively reducing a scan target area of said optical scanner.” (Claim 14) (emphasis added).

Under the analysis required by *Graham v. John Deere*, 383 U.S. 1 (1966) to support a rejection under § 103, the scope and content of the prior art must first be determined, followed by an assessment of the differences between the prior art and the claim at issue in view of the ordinary skill in the art. In the present case, the scope and content of the prior art,

as evidenced by Fredlund and Takeda, did not include the claimed subject matter, particularly an optical scanner comprising “a shade reel disposed at an edge of a scanning bed of said optical scanner” and a “a shade coupled to said shade reel” (claim 14). The cited prior art also does not provide “an underside of said shade that is presented to said scanning bed is colored such that said optical scanner does not output any image markings when scanning said underside of said shade thereby effectively reducing a scan target area of said optical scanner.” (Claim 14).

The differences between the cited prior art and the claimed subject matter are significant because the claimed subject matter provides feature and advantages not known or available in the cited prior art. Consequently, the cited prior art will not support a rejection of claim 14 under 35 U.S.C. § 103 and *Graham*. For at least these reasons, the rejection based on Fredlund and Takeda of claim 14 and its dependent claims should not be sustained.

Claims 7, 10, 16, 17 and 23:

As noted above, claim 7 recites “wherein said adjustable shade further comprises a shade reel including a spring and a lock mechanism.” Claims 10, 16, 17 and 23 recite similar or related subject matter. Neither Fredlund nor Takeda teach or suggest this subject matter.

In this regard, the Answer argues that “Takeda discloses at Col. 6, lines 12-20- thus when the light shield is moved by the motor the plates stays and locked at the place for the scanning operation to take place and therefore teaches wherein said adjustable shade further comprises a shade reel including a spring and a lock mechanism.” (Answer, p. 19). This is simply reading subject matter into Takeda that is *not* there.

As described above, Takeda teaches light shielding plates that are moved by motorized screws. (Takeda, col. 6, lines 12-22). here is no reason to suspect that such a

system includes “a spring” or a “lock mechanism” with respect to a “reel” as recited in claims 7, 10, 16, 17 and 23. Thus, the Answer and previous prosecution have failed to establish how or where the cited prior art actually teaches the subject matter recited in these claims.

In truth, the combination of Fredlund and Takeda clearly fails to include the claimed “adjustable shade further compris[ing] a shade reel including a spring and a lock mechanism.” For at least this additional reason, the rejection of claims 7, 10, 16, 17 and 23 should not be sustained.

Claim 8:

Claim 8 recites “wherein said opaque material is coiled around said shade reel.” Claims 14-17 recite similar subject matter.

In this regard, the Answer argues that “Takeda shows clearly that the plates when retracted will be coiled to its location,” and refers to Takeda at col. 6, lines 12-22. (Answer, p. 19). This portion of Takeda merely describes the motorized movement of the apparently rigid light shield plates.

Nothing in either of the cited references describes an opaque material coiled around a shade reel as claimed by Appellant. Consequently, the rejection of claims 8 and 14-17 should not be sustained for at least this additional reason.

In view of the foregoing, it is submitted that the final rejection of the pending claims is improper and should not be sustained. Therefore, a reversal of the Rejection of June 22, 2009 is respectfully requested.

Respectfully submitted,

DATE: March 19, 2010

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